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Rec'd PCT/PTO 17 JUL 2001

**PATENT**

Attorney Docket No.: 29992/35364

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In the Application of:  
Weinberg *et al.*

Serial No.: 09/622,816

Filed: August 23, 2000

For: Lipid Emulsions in the  
Treatment of Systemic  
Poisoning

Group Art Unit: To be assigned

Examiner: To be assigned

) CERTIFICATE OF MAILING BY

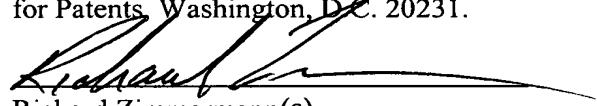
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) Date of Deposit: 9 July 2001

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) for Patents, Washington, D.C. 20231.

)   
) Richard Zimmermann(s)

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**17 JUL 2001**

Legal Staff

International Division

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**MAR 12 2002**

**TECH CENTER 1600/2300**

**RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371  
IN THE UNITED STATES DESIGNATED/ELECTED OFFICE DO/EO/US  
AND**

**REQUEST TO RESCIND NOTIFICATION OF ABANDONMENT**

Commissioner for Patents  
Box PCT  
ATTENTION: Legal Office  
Washington, D.C. 20231

Sir:

65.00 0P

This document is in response to a "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office DO/EO/US" dated May 9, 2001, and a "Notification of Abandonment" dated June 4, 2001.

As was discussed recently by telephone with Ms. Shelby J. Vigil (PCT Branch),

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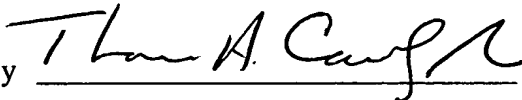
a "Notification of Abandonment" (copy attached hereto as *Appendix A*) was erroneously issued on this application (mailed June 4, 2001). The history of the notification of abandonment began with an erroneous notification of acceptance (mailed September 18, 2000; copy attached hereto as *Appendix B*), which listed the oath or declaration as having been received by the USPTO, when in fact the oath/declaration had not been received). The undersigned contacted Ms. Shelby Vigil by telephone to discuss this error.

In response to the undersigned's inquiry, the USPTO-PCT Legal Office acknowledged this error and vacated the notification of acceptance in a decision mailed May 2, 2001; copy attached hereto as *Appendix C*). On May 9, 2001, the PCT Branch (again under the signature of Ms. Vigil) issued a "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office DO/EO/US" (copy attached as *Appendix D*) noting the missing inventors' oath/declaration.

On June 4, 2001, the PCT Branch mailed (yet again under the signature of Ms. Vigil) the present notification of abandonment (copy attached as *Appendix A*). In view of the fact that the Patent Office (1) erroneously issued the notification of acceptance, (2) vacated said acceptance, and (3) properly issued a notification of missing requirements, the applicants submit that the notice of abandonment is improper and request that said notice (of abandonment) be withdrawn.

In response to the "Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office DO/EO/US" dated May 9, 2001, the applicants enclose herewith (as *Appendix E*) a properly executed inventors' oath/declaration. Also enclosed herewith (in the form of a check) is the proper patent application processing for late submission of the oath/declaration.

Respectfully submitted,

By 

Thomas A. Cawley, Jr., Ph.D.  
Registration No.: 40, 944  
Attorney for Applicant  
MARSHALL, O'TOOLE, GERSTEIN,  
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233 South Wacker Drive, Suite 6300  
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July 9, 2001

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JUN 8 2001

MARSHALL O'TOOLE



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS

Box PCT

Washington, D.C. 20231

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/622816	WEINBERG	G 27611 35364
INTERNATIONAL APPLICATION NO.		
PCT/US99/03805		
I.A. FILING DATE	PRIORITY DATE	
22 FEB 99	24 FEB 98	

DAVID W CLOUGH  
6300 SEARS TOWER  
233 S WACKER DRIVE  
CHICAGO, IL 60606

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DATE MAILED:

04 JUN 2001

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NOTIFICATION OF ABANDONMENT

The United States Patent and Trademark Office in its capacity as

☐ a Designated Office (37 CFR 1.494), ☒ an Elected Office (37 CFR 1.495), has made the following determination:

- ☐ Applicant's letter of express abandonment received \_\_\_\_\_ is in compliance with CFR 1.138 and is hereby acknowledged.
- ☐ Applicant has failed to provide the full U.S. Basic National Fee by ☐ 20 months (37 CFR 1.494(b)(2)), ☐ 30 months (37 CFR 1.495(b)(2)).
- ☒ Applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed 18 sept 2000 within the time period set therein.
- ☐ Applicant has failed to properly respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed \_\_\_\_\_ within the time period set therein. See the attached NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916).
- ☐ Other.

Therefore, the above identified application failed to meet the requirements of 35 U.S.C 371 and 37 CFR ☐ 1.494, ☒ 1.495 and is ABANDONED AS TO THE UNITED STATES OF AMERICA.

Shelby J. Vigil

Telephone: 703-305-3653



## UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

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MAR 12 2002

U.S. APPLICATION NO. 09/622816 FIRST NAMED APPLICANT WEINBERG ATTY. DOCKET NO. G TECH 27611-35364

DAVID W CLOUGH  
6300 SEARS TOWER  
233 S WACKER DRIVE  
CHICAGO, USX 60606RECEIVED  
OCT 8 2000  
MARSHALL O'TOOLE

INTERNATIONAL APPLICATION NO. 1000/2900

PCT/US99/03805

I.A. FILING DATE

PRIORITY DATE

22 FEB 99

24 FEB 98

DATE MAILED 18 SEP 2000

NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371  
AND 37 CFR 1.494 OR 1.495

1. The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as ☐ a Designated Office (37 CFR 1.494), ☒ an Elected Office (37 CFR 1.495), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is **ACCEPTED** for national patentability examination in the United States Patent and Trademark Office.

2. The United States Application Number assigned to the application is shown above and the relevant dates are:

23 aug 2000  
35 U.S.C. 102(e) DATE23 aug 2000  
DATE OF RECEIPT OF  
35 U.S.C. 371 REQUIREMENTS

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE APPEARING ON THE FILING RECEIPT AS THE "FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371(C) REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363). Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

3. ☐ A request for immediate examination under 35 U.S.C. 371(f) was received on \_\_\_\_\_ and the application will be examined in turn.

4. The following items have been received:

☒ U.S. Basic National Fee.☒ Copy of the international application in:☐ a non-English language.☒ English.☒ Translation of the international application into English.☒ Oath or Declaration of inventor(s) for DO/EO/US.☐ Copy of Article 19 amendments. ☐ Translation of Article 19 amendments into English.The Article 19 amendments ☐ have ☐ have not been entered.☐ The International Preliminary Examination Report in English and its Annexes, if any.☐ Copy of the Annexes to the International Preliminary Examination Report (IPER).☐ Translation of Annexes to the IPER into English.The Annexes ☐ have ☐ have not been entered.☐ Preliminary amendment(s) filed \_\_\_\_\_ and \_\_\_\_\_.☐ Information Disclosure Statement(s) filed \_\_\_\_\_ and \_\_\_\_\_.☐ Assignment document.☐ Power of Attorney and/or Change of Address.☐ Substitute specification filed \_\_\_\_\_.☐ Verified Statement Claiming Small Entity Status.☐ Priority Document.☐ Copy of the International Search Report ☐ and copies of the references cited therein.☐ Other: \_\_\_\_\_

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

SHELBY VIGIL, PARALEGAL

Telephone: 703-305-3653

MAY 02 2001



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Patent Cooperation Treaty  
Legal Office

Address: Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231

David W. Clough  
6300 Sears Tower  
233 S. Wacker Drive  
Chicago, IL 60606

In re Application of  
Weinberg et al.  
Application No.: 09/622816  
PCT No.: PCT/US99/03805  
Int. Filing Date: 22 February 1999  
Priority Date: 24 February 1998  
Attorney's Docket No.: 27611 35364  
For: Lipid Emulsions in the Treatment  
of Systemic Poisoning

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TECH CENTER 1600/2900  
COMMUNICATION

This communication concerns issues arising under 35 U.S.C. 371.

**BACKGROUND**

This international application was filed on 22 February 1999, and claimed a priority date of 24 February 1998. A Demand electing the United States was filed on 13 September 1999, which was prior to the elapse of 19 months from the priority date. Accordingly, the thirty-month time period to pay the basic national fee in the United States expired as of midnight on 24 August 2000.

On 23 August 2000, applicants filed, *inter alia*, the basic national fee and a surcharge under 37 CFR 1.492(e), but did not file an oath or declaration of the inventors.

On 18 September 2000, a Notification of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating that the 35 U.S.C. 371 date of this application was 23 August 2000.

**DISCUSSION**

Review of the record reveals that applicants have not yet satisfied the requirements of 35 U.S.C. 371(c)(4) because no adequate oath or declaration has been filed. Accordingly, the Notification of Acceptance mailed on 18 September 2000 was inappropriate and is hereby **VACATED**.

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DECISION

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for continued processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the filing of an oath or declaration of the inventors.

  
for

Boris Milef  
PCT Legal Examiner  
PCT Legal Office



George M. Dombroske  
PCT Legal Examiner  
PCT Legal Office  
Tel: (703) 308-6721  
Fax: (703) 308-6459



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231  
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/622816	WEINBERG	G 27611 35364
INTERNATIONAL APPLICATION NO.		

DAVID W CLOUGH  
6300 SEARS TOWER  
233 S WACKER DRIVE  
CHICAGO, IL 60606

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MAY 15 2001

MARSHALL COLE

Docketed: 7/9/01

PCT/US99/03805

I.A. FILING DATE PRIORITY DATE

22 FEB 99

24 FEB 98

DATE MAILED: 09 MAY 2001

**NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)**

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- |   |   |
|---|---|
| <input checked="" type="checkbox"/> U.S. Basic National Fee.  | <input type="checkbox"/> Indication of Small Entity Status.                         |
| <input checked="" type="checkbox"/> Copy of the international application.  | <input type="checkbox"/> Translation of the international application into English. |
| <input type="checkbox"/> Oath or Declaration of inventors(s).   | <input type="checkbox"/> Translation of Article 19 amendments into English.         |
| <input type="checkbox"/> Copy of Article 19 amendments.   | <input type="checkbox"/> Other:   |
| <input type="checkbox"/> Priority Document.   |   |
| <input type="checkbox"/> The International Preliminary Examination Report in English and its Annexes, if any.     |   |
| <input type="checkbox"/> Translation of Annexes to the International Preliminary Examination Report into English. |   |

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- ☐ U.S. Basic National Fee. ☐ Copy of the international application.

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
- ☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☒ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$ \_\_\_\_\_ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

**ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.
7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

**A copy of this notice MUST be returned with this response.**

- Enclosed: ☐ PCT/DO/EO/917 ☐ Notice of Defective Translation  
☐ PTO-875 ☐ PCT/DO/EO/920

Shelby J. Vigil

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3653



## APPLICABLE RULES AND STATUTES

### 37 CFR 1.56. DUTY OF DISCLOSURE - INFORMATION MATERIAL TO PATENTABILITY (Applicable Portion)

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is canceled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is canceled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentability defines, to make sure that any material information contained therein is disclosed to the Office.

Information relating to the following factual situations enumerated in 35 USC 102 and 103 may be considered material under 37 CFR 1.56(a).

### 35 U.S.C. 102. CONDITIONS FOR PATENTABILITY: NOVELTY AND LOSS OF RIGHT TO PATENT

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraph (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent, or
- (f) he did not himself invent the subject matter sought to be patented, or
- (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

### 35 U.S.C. 103. CONDITIONS FOR PATENTABILITY; NON-OBVIOUS SUBJECT MATTER (Applicable Portion)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

### 35 U.S.C. 112. SPECIFICATION (Applicable Portion)

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.